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Commissioner for Patents

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Transmitted to USPTO Central Fax No. 703-872-9306

Re: OSHIDA *et al.*, Serial No. 09/678,652RCE
Att'y Docket 500.39147X00
Ex. Sisson/AU 1634/USPTO Conf. No. 7028

SUBMISSION OF PETITION TO THE COMMISSIONER UNDER 37 CFR §1.181

Sir:

Applicant hereby transmits the attached "PETITION TO THE COMMISSIONER UNDER 37 CFR §1.181" (3 pages) regarding the above-identified application.

CERTIFICATE OF TRANSMISSION:

I hereby certify that the attached "PETITION TO THE COMMISSIONER UNDER 37 CFR §1.181" (3 pages) is being **FORMALLY TRANSMITTED** via the USPTO

Central Fax No. 703-872-9306 on 5 February 2004.


Patricia J. Jaquet

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500.39147X00/E5532-01EX

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

Applicant: Yoshitada OSHIDA *et al.*
Serial No.: 09/678,652RCE
Filed: 4 October 2000
For: METHOD OF INSPECTING A DNA
CHIP AND AN APPARATUS THEREOF
Group: 1634
Examiner: Bradley L. SISSON
Conf. No.: 7028

PETITION TO THE COMMISSIONER UNDER 37 CFR §1.181

Mail Stop AF
Commissioner for Patents
POB 1450
Alexandria, Virginia 22313-1450

5 February 2004

Sir:

**Applicant respectfully petitions the Commissioner for relief from the
improper examination procedures in the above-identified application.**

This paper is responsive to the final Office Action having a USPTO mailing date of 5 November 2003, Applicant's Request For Corrected Office Action And Restart Of The Period For Response filed 24 November 2003, and the USPTO Communication dated 9 January 2004.

Facts are as follows: Applicant submitted an Amendment After Final Rejection on 21 April 2003 and received an Advisory Action having a USPTO mailing date of 15 May 2003 denying entry of such Amendment because the changes would "raise new issues that would require further consideration and/or search." Therefore,

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Applicant timely (under §136 Petition and fee) filed a Request for Continued Examination (RCE) on 21 July 2003, in which entry and consideration of Applicant's 21 April 2003 Amendment After Final Rejection was properly requested.

A first Office Action in the RCE was mailed on 5 November 2003, which Action was defective in that it contained an improper final rejection. That is, MPEP §706.07(b) states in relevant part that "it would not be proper to make final a first Office Action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because new issues were raised that required further consideration and/or search." As the Examiner indicated that new issues were raised that required further consideration and/or search in the Amendment After Final Rejection, it is respectfully submitted that the Examiner was therefore barred from making the first Action final in the present RCE.

In view of the defect in the 5 November Office Action, Applicant timely (within one month of the defective Action) filed a Request For Corrected Office Action And Restart Of The Period For Response on 24 November 2003.

An Office Communication mailed 9 January 2004 states that the holding of finality in the 5 November 2003 Office Action was premature, and that such finality has been withdrawn. Thus, the USPTO acknowledges that the 5 November 2003 Action was defective, and in accordance with MPEP §710.06, the period for response to the 5 November 2003 should have been restarted as requested by Applicant.

During a teleconference held with Examiner Bradley Sisson on 2 February 2004, the Examiner stated that the period for response to the defective 5 November

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2003 Action would not be restarted. MPEP §710.06 explicitly and clearly states *verbatim* "[w]here the citation of a reference is incorrect or an Office action contains some other defect and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant" (emphasis added).

The admission within the 9 January 2004 Communication that the finality of the 5 November 2003 Action was improper clearly qualifies as a "defect" or "error," and Applicant clearly submitted the 24 November 2003 Request within one month from the 5 November 2003 defective Office Action. Accordingly, Applicant again respectfully requests restart of the period for response to the 5 November 2003 Office Action.

Respectfully submitted,



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